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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,680	01/23/2004	Andrew Halliday	1410/67626	7480

48940 7590 01/18/2008  
FITCH EVEN TABIN & FLANNERY  
120 S. LASALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER
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ALEXANDER, REGINALD

ART UNIT	PAPER NUMBER
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3742

MAIL DATE	DELIVERY MODE
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01/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/763,680

Applicant(s)

HALLIDAY ET AL.

Examiner

Reginald L. Alexander

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,40-42 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46-50 is/are allowed.
- 6) ☒ Claim(s) 1,3-12,40-42 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/763,534. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are an obvious variation of the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piana in view of Fischbach et al.

There is disclosed in Piana a cartridge for use in a beverage preparation machine, the cartridge containing a beverage ingredient (such as chocolate) and being formed from substantially air and water impermeable materials (plastic), the cartridge including an inner member 14 and outer member 12, an inlet 44, an outlet 28 and means 22 for forming a jet of liquid. In regards to when the inner member and outer member are joined, such is considered a method of forming the device and is not germane to the issue of patentability of the device itself. Therefore this limitation has not been given patentable weight.

Fischbach discloses that it is known in the art to provide a liquid ingredient (such as chocolate syrup or gel) within a capsule (cartridge) and provide hot water to the capsule for the formation of a hot beverage.

It would have been obvious to one skilled in the art to substitute the powdered chocolate ingredient of Piana with the liquid chocolate ingredient taught in Fischbach, in order to provide an form of ingredient which dissolves faster upon contact with hot water.

In regards to the percentage of solids and viscosity of the ingredients, such is an obvious matter of design choice to one skilled in the art, since the final taste of the beverage is determined by adjustments to such variables. One skilled in the art would provide the necessary adjustments to suit their taste and desires.

Claims 1, 3-12 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Favre et al. '052 in view of Fischbach et al.

There is disclosed in Favre a cartridge for use in a beverage preparation machine, the cartridge formed by inner member 3 and outer member 15, the cartridge containing one or more ingredients 17, the cartridge having an inlet 5 for the introduction of a liquid into the cartridge and an outlet 22 for discharge of a beverage and at least one inlet 24 for air and means 24 and tapered passageway at outlet 22 for generating a pressure reduction of a jet of beverage, whereby, in use, air from the air inlet is incorporated into the beverage.

Fischbach discloses that it is known in the art to provide a liquid ingredient (such as chocolate syrup or gel) within a capsule (cartridge) and provide hot water to the capsule for the formation of a hot beverage.

It would have been obvious to one skilled in the art to substitute the powdered coffee ingredient of Favre with the liquid chocolate ingredient taught in Fischbach, in order to provide a form of ingredient which dissolves faster upon contact with hot water.

***Allowable Subject Matter***

Claims 46-50 are allowed.

***Response to Arguments***

Applicant's arguments filed 31 October 2007 have been fully considered but they are not persuasive. Applicant argues that the cartridge 16 of Favre fails to have an inlet, an outlet and an air inlet. It should be noted that element 16 is not what the examiner considers to be the cartridge. The cartridge is formed by inner member 3 and outer member 15 together. Applicant argues that because the lid part 14 of Piana is not disposed entirely within the cup part 12, it is not contained within the inner member, as is now claimed. It is the opinion of the examiner that the phrase "contained" is not limited to an entire portion of an element being within another element. So long as a portion of the lid is within the cup it is contained therein.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reginald L. Alexander whose telephone number is 571-272-1395. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rla  
14 January 2008

  
Reginald L. Alexander  
Primary Examiner  
Art Unit 3742